

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Status of the Claims

Claims 1, 3-6, and 8-18 are pending in the above-identified application. Claims 10-18 are currently withdrawn from consideration. Support for the amendment to claim 1 can be found in Examples 1, 4, and 6 of the present specification as well as claim 19. As such, claim 19 is cancelled herein. Thus, no new matter has been added.

Applicants submit that the present Amendment reduces the number of issues under consideration and places the case in condition for allowance. Alternatively, entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 103(a)

1) Claims 1, 3, 8-9, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cuisin et al. in view of Fujikawa et al.

2) Claims 4-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cuisin et al. in view of Fujikawa et al. and further in view of Li et al.

3) Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cuisin et al. in view of Fujikawa et al. and further in view of Kenausis et al.

Applicants respectfully traverse. Reconsideration and withdrawal of these rejections are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions over the Cited References

As amended, claim 1 recites the step of activating the mold by oxygen plasma treatment or ozone oxidation treatment between (i) forming a mold by a lithographic method on a solid substrate having a surface coated with a resist material containing a hydroxyl group or a carboxyl group, the mold being made from the resist material, and (ii) forming a metal oxide thin film or an organic/metal oxide composite thin film on the formed mold. Accordingly, the activating process is for activating the mold before a substance (a metal oxide or the like) is attached to the mold.

In contrast, Fujikawa et al. disclose removing the mold after a substance is attached to the mold. Since the process of the present invention activates the mold, the substance can be more selectively attached to the mold.

On page 7, paragraph 28 of the outstanding Office Action, the Examiner states:

Regarding claim 7, which has been incorporated into amended claim 1, applicant argues that there is no motivation for the combination of Cuisin and Fujikawa, specifically because a person skilled in the art would consider that the hydroxyl/carboxyl group are present before the mold is formed and would undergo a chemical change. However, it is noted that the features upon which applicant relies (i.e., that the resist layer is formed is not subjected to the lithographic/mold forming step) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Claim 1 is amended herein to clarify that the mold is made from the resist material. Accordingly, the surface of the substrate, which is coated with the resist material, is subjected to the lithographic process, thereby forming the mold made from the resist material.

As described above, the mold made from the resist material is formed by lithography, and the formed mold is activated by oxygen plasma treatment or ozone oxidation treatment. Then, the substance (a metal oxide or the like) is brought into contact with (the forming surface of) the formed mold. Since a hydroxyl or carboxyl group is present at (the forming surface of) the activated mold, the organic/metal oxide composite thin film is formed on (the forming surface of) the activated mold. Then, in step (iii) of claim 1, the formed mold is removed.

In contrast, Cuisin et al., Fujikawa et al., Li et al., and Kenausis et al. do not disclose that the formed mold is treated by oxygen plasma treatment or ozone oxidation treatment between steps (i) and (ii) of claim 1.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Cuisin et al. in view of Fujikawa et al., with or without the other cited references, fail to disclose all of the claim limitations of independent claim 1, and those claims dependent thereon. Accordingly, the combination of references does not render the present invention obvious.

Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejections is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1, 3-6, and 8-9 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: January 28, 2010

Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants